

Appl. No. : 10/719,419
Filed : November 21, 2003

REMARKS

In the October 1, 2004 Office Action, the Examiner states that Claims 4, 15, 16, 18, and 25 would be allowable if rewritten in independent form; rejects Claims 20-25 under 35 U.S.C. § 112, first paragraph; rejects Claims 1, 19, and 20 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,566,596 to Askew ("Askew"); rejects Claims 2, 5-10, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Askew in view of U.S. Patent No. 6,455,864 to Featherby, et al ("Featherby"); and rejects Claims 3, 11, 13-18, and 21-24 under 35 U.S.C. § 103(a) as being unpatentable over Askew in view of U.S. Patent No. 5,939,772 to Hurst, et al ("Hurst"). Applicants request reconsideration of the rejections in view of the following comments and amendments.

For the purposes of responding to the Office Action, Applicants will treat all of the cited references as prior art, but Applicants reserve the right to remove one or more of the references under common ownership.

Allowable Subject Matter

Applicants thank the Examiner for finding that Claims 4, 15, 16, 18, and 25 would be allowable if rewritten in independent form. As will be discussed in greater detail later, in view of the patentability of Claim 1, from which Claims 4, 15, 16, and 18 depend, and the patentability of Claim 20, from which Claim 25 depends, Applicants have not rewritten Claims 4, 15, 16, 18, and 25 in this response. In addition, Applicants note that the Examiner lists Claim 25 with both the objected to, but allowable claims and with the rejected claims.

Rejections of Claims 20-25 Under 35 U.S.C. § 112, First Paragraph

The Examiner rejects Claims 20-25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. With respect to Claim 20, the Examiner states that the previously-added limitation "a thickness of the magnetic shield layer is tailored to a strength of an external magnetic field of an intended environment" from the prior Office Action Response is not described "in the specification or in any Figure." Claims 21-25 have been rejected as depending from a rejected base claim.

Applicants respectfully maintain that the previously-added limitation is supported by the specification and respectfully traverse. For example, the disclosure states "[t]he thickness of the shielding can be tailored to a customer's specific needs," see the Abstract. In addition, the

Appl. No. : 10/719,419
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disclosure states "[t]hus, the magnetic shielding can be tailored to meet the specific needs of the customer without incurring the expense of over-shielding or the risk of under-shielding," see paragraph [0024]. Also, the disclosure states "[s]ome devices may be located in environments with strong external magnetic fields, and some may be located in environments where external magnetic fields are negligible," see paragraph [0021].

Accordingly, Applicants respectfully submit that the previously-added limitation in Claim 20 is fully supported by the specification and complies with 35 U.S.C. § 112, first paragraph. Therefore, Applicants respectfully request the Examiner to withdraw the rejection to Claims 20-25 under 35 U.S.C. § 112, first paragraph.

Rejections of Independent Claims 1 and 20 Under 35 U.S.C. § 102(e) to Askew

The Examiner rejects Claims 1 and 20 under 35 U.S.C. § 102(e) as anticipated by Askew. In response, Applicants have amended Claims 1 and 20 (and applicable dependents) to clarify the claimed invention. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," see MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner states that Askew teaches "applying a film of magnetic shield material 22 to at least one outer surface of the molded housing 20..." Applicants note that Askew's tertiary layer 22 corresponds to "a composite material, for example a composite made of an industry standard encapsulant, such as the epoxy cresol novolac polymer, which is impregnated with magnetically permeable material particles," see Col. 4, lines 22-25. Askew describes that "a polymer material and a magnetically permeable material are composited (i.e., mixed together ...) to form a composite polymer material," see Col. 6, lines 48-52. Applicants note that it is Askew's material that is being formed at this stage. Askew then describes that "the polymer layer is covered with a layer of the composite polymer material (e.g., the tertiary layer 22 which may be a composited epoxy and magnetically permeable particles)."

Accordingly, Askew's tertiary layer 22 is formed on the device 12 and not preformed. Applicants have amended Claim 1 to clarify that the film is preformed. This limitation is supported by, for example, "at least one magnetically permeable foil is applied to an outer surface of the molded body," see paragraph [0011], and "[t]he sheet of magnetic shield material

Appl. No. : 10/719,419
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84 is cut to fit the size of the recess 74," see paragraph [0041]. Applicants have also amended Claim 20 to clarify that the magnetic shield layer is preformed.

Accordingly, Applicants respectfully submit that Askew does not teach or suggest Applicants' invention as defined by amended Claims 1 or 20, and Applicants request allowance of Claims 1 and 20.

Improper to Combine Askew and Hurst

The Examiner rejects dependent Claims 3, 11, 13-18, and 21-24 under 35 U.S.C. § 103(a) as being unpatentable over Askew in view of Hurst. Applicants respectfully submit that Askew and Hurst cannot be combined in the manner suggested by the Examiner. "It is improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), M.P.E.P. § 2145(X)(D)(2).

Askew teaches "a composite material, for example a composite made of an industry standard encapsulant, such as the epoxy cresol novolac polymer, which is impregnated with magnetically permeable material particles," see Col. 4, lines 22-25.

Hurst describes "a completely inorganic packaging approach," see Col. 2, line 51. Hurst further describes that "it is desirable to have a hermetically sealed package that is free from any internal organic materials such as epoxy materials," see Col. 1, lines 37-39. Therefore, Applicants respectfully submit that it is improper to combine Askew and Hurst because Hurst teaches away from the use of molding materials, such as epoxy.

In addition, Applicants respectfully submit that the rejections to dependent Claims 3, 11, 13-18, and 21-24 are moot in light of the patentability of Claims 1 and 20, respectively. Accordingly, Applicants respectfully request the Examiner to withdraw the rejections of Claims 3, 11, 13-18, and 21-24 under 35 U.S.C. § 103(a) as being unpatentable over Askew in Hurst, and respectfully request allowance of the same.

Rejections of Dependent Claims 2, 5-10, and 12

Dependent Claims 2, 5-10, and 12 depend from and further define Claim 1. The dependent claims recite numerous additional distinctions over the cited references.

For example, the Examiner rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Askew and Featherby. Applicants respectfully submit that

Appl. No. : 10/719,419
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the combination of Askew and Featherby does not teach or suggest "where the plastic substrate comprises a ball grid array substrate," as recited in Claim 7.

In another example, the Examiner rejects Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Askew and Featherby. Applicants respectfully submit that the combination of Askew and Featherby does not teach or suggest "bonding solder bumps on the semiconductor die to electrical traces on the plastic substrate before forming the molded housing," as recited in Claim 9.

In addition, Applicants respectfully submit that the rejections to dependent Claims 2, 5-10, and 12 are moot in light of the patentability of Claim 1, respectively, and Applicants therefore request allowance of Claims 2, 5-10, and 12.

Summary

In view of the foregoing remarks, Applicants respectfully request the Examiner to withdraw the rejections of Claims 20-25 under 35 U.S.C. § 112, first paragraph; Claims 1 and 20 under 35 U.S.C. § 102(e); and Claims 2, 3, 5-14, 17, 19, and 21 under 35 U.S.C. § 103(a). Applicants further request the Examiner to allow Claims 1-25 and to pass the present application to the issue process.

If there is any further impediment to the prompt allowance of the present application, Applicants request the Examiner to call the undersigned attorney of record at 310-407-3466 or at the telephone number listed below to resolve any such impediment.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 3, 2005

By: Michael S. Okamoto
Michael S. Okamoto
Registration No. 47,831
Attorney of Record
Customer No. 20,995
(310) 551-3450

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